THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES G. DICKERSON, JEFFREY L. DEBARR
and JUDITH M. VANDEWINCKEL

Appeal No. 1997-1752
Application No. 08/451,379[1]

ON BRIEF

Before KIMLIN, WARREN and SPIEGEL, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 4-25 and 28-33, all the claims remaining in the present application. Claim 1 is illustrative:

---

[1] Application for patent filed May 26, 1995.

1. A process for the preparation of colored toners consisting essentially of mixing a first toner consisting essentially of resin, pigment particles, charge additive, and surface additives of zinc stearate and fumed silica, each present in an amount of from about 0.4 to about 0.8 weight percent, with a second toner consisting essentially of resin, pigment particles, and charge additive, and wherein the resulting colored toners contain from about 0.2 to about 0.3 weight percent of said zinc stearate and from about 0.2 to about 0.3 weight percent of said fumed silica.

The examiner relies upon the following references as evidence of obviousness:

Gruber et al. (Gruber)	4,965,158	Oct. 23, 1990
Nash et al. (Nash)	5,510,220	Apr. 23, 1996 (filed Jan. 27, 1995)

Handbook of Imaging Materials 169 (Arthur S. Diamond ed., Marcel Dekker, Inc. 1991) (Diamond)

Appellants' claimed invention is directed to a process for preparing colored toners. The process involves mixing a first toner, consisting essentially of resin, pigment, charge additive and surface additives, with a second toner consisting essentially of the same components minus the surface additives. The surface additives of the first toner are zinc stearate and fumed silica.

Appealed claims 1, 4-25 and 28-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nash in view of Diamond and Gruber.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find ourselves in agreement with appellants that the prior art cited by the examiner fails to establish a prima facie case of obviousness for the claimed process. Accordingly, we will not sustain the examiner's rejection.

The examiner correctly points out that Nash exemplifies toner compositions comprising the claimed components, including surface additives of zinc stearate and fumed silica in the recited amounts. However, as urged by appellants, the claimed invention presently on appeal defines a process for preparing colored toners and developer compositions. Significantly, whereas the appealed claims define a process of mixing first and second toners wherein only the first toner includes surface additives of zinc stearate and fumed silica, the examiner points to no teaching in Nash regarding the mixing of toners, let alone toners of different composition. Consequently, in view of this lack of teaching or suggestion by Nash of blending two toners having distinct compositions, we do not agree with the examiner

that Nash supports a prima facie case of obviousness for the claimed process steps.

The examiner cites case law for the proposition that "it is *prima facie* obvious to select any order of adding materials in order to form the final product of the reference" (page 4 of Answer). While this has generally been held to be true by our review court, the claimed process entails something other than just changing the order of mixing various ingredients. For one, the claimed process requires a mixing of different toners and, as noted above, the examiner has not referenced any disclosure in Nash, or any other reference, that such mixing was known in the art. Also, appellants' process requires the first toner to have surface additives of zinc stearate and fumed silica and the second toner to have no surface additives. If the claimed invention defined a process of preparing a toner by first adding pigment particles and then surface additives rather than a prior art technique of first adding surface additives and then pigment particles, the cases cited by the examiner would be more appropriate.

One final point remains. Upon return of this application to the examiner, we recommend that the examiner consider the

patentability of the appealed claims in view of the disclosure of U.S. Patent No. 5,370,962 to Anderson et al. (hereinafter U.S. '962), notwithstanding the examiner's rejection under 35 U.S.C. § 103 over this patent in the first Office Action of January 26, 1996, and subsequent withdrawal of such rejection. Appellants' present specification, at page 3, characterizes U.S. '962 as disclosing a process of blending a first toner and a second toner wherein surface additives are optional components of both toners. The surface additives of the reference are the same as those employed by appellants. Since U.S. '962 discloses the optional inclusion of the presently claimed surface additives in both the first and second toners, it would seem that it would have been prima facie obvious for one of ordinary skill in the art to incorporate a surface additive in only the first toner, as presently claimed. While appellants argued in their response of April 26, 1996, that U.S. '962 discloses that surface blend compatibility components are important features of the disclosed toners, it is our opinion that the appealed claims do not exclude such surface blend compatibility components. Indeed, EXAMPLE I of the present invention discloses a first toner comprising

distearyl dimethyl ammonium methyl sulfate, and U.S. '962 discloses distearyl dimethyl ammonium methyl sulfate as a known blend compatibility additive (see column 6, lines 57 and 58). Also, it is our view that the claim language "consisting essentially of" does not exclude the blend compatibility components of U.S. '962, inasmuch as the incorporation of such components into the presently claimed toners and developers would not materially affect the basic and novel characteristics of the claimed compositions. Accordingly, we urge the examiner to carefully consider the obviousness of the subject matter defined by the appealed claims in view of U.S. '962, considered alone, or in combination with other prior art of record, e.g., U.S. Patent No. 5,510,220 to Nash et al.

In conclusion, based on the foregoing, we are constrained to reverse the examiner's rejection.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CAROL A. SPIEGEL Administrative Patent Judge	)	

ECK:clm

Ronald Zibelli
Xerox Corp.
Xerox Square 020
Rochester, NY 14644